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Docket No.: A-2875

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Alfred K. Dassler

August 13, 2008
Date

MAIL STOP: APPEAL BRIEF-PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Applic. No.	:	09/981,847	Confirmation No.: 7052
Inventor	:	Edelbert König	
Filed	:	October 18, 2001	
Title	:	Method for Transmitting Data Between a First and a Second Computing Unit	
TC/A.U.	:	2153	
Examiner	:	Lashanya R. Nash	
Customer No.	:	24131	

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

08/14/2008 HMARZI1 00000042 09981847
01 FC:1402 510.00 OP

BRIEF ON APPEAL

Sir:

This is an appeal from the final rejection in the Office action dated April 17, 2008, finally rejecting claims 1 and 3 - 13.

$500.00 fee of Brief on Appeal was paid on December 21, 2005. The difference of $10 for the current fee of Brief on Appeal is enclosed herewith.

Adjustment date: 08/14/2008 HMARZI1
12/28/2005 DENNANJ1 00000047 09981847
01 FC:1402 -500.00 OP

Real Party in Interest:

This application is assigned to Heidelberger Druckmaschinen AG of Germany. The assignment will be submitted for recordation upon the termination of this appeal.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 1 and 3 - 13 are rejected and are under appeal. Claim 2 is canceled.

Status of Amendments:

No claims were amended after the final Office action.

Summary of the Claimed Subject Matter:

As stated in the first paragraph on page 1 of the specification of the instant application, the invention relates to a method for transmitting data between two computing units.

The subject matter of each independent claim is described in the specification of the instant application. Examples explaining the subject matter defined in each of the independent claims, referring to the specification by page and line numbers, and to the drawings, are given below.

Independent method claim 1 recites a method for establishing a data connection and for transmitting data from a first computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)* to a second computing unit *(Figs. 1 and 2, ref. # 2, page 8, line 16)*, which comprises:

in the first computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)*, selecting and reading out from a database *(Fig. 2, ref. # 16, page 10, line 1)*, in a selection program, an address of the second computing unit *(Figs. 1 and 2, ref. # 2, page 8, line 16)* controlling a printing unit *(Fig. 1, ref. # 9, page 8, line 19)*;

establishing a connection (Fig. 4, ref. # 120, page 17, lines 5-8) with the address of the second computing unit*(Figs. 1 and 2, ref. # 2, page 8, line 16)*;

initially performing a version comparison between the first *(Figs. 1 and 2, ref. # 1, page 8, line 12)* and the second computing units *(Figs. 1 and 2, ref. # 2, page 8, line 16)* with respect to an employed communications protocol;

after the communications protocol is determined, establishing a data connection for transmitting data (Fig. 4, ref. # 130, page 13, line 25 to page 14, line 3);

displaying a specified number of diagnostic programs (Fig. 4, ref. # 140, page 15, line 25) stored in the second computing unit *(Figs. 1 and 2, ref. # 2, page 8, line 16)* after the data connection is established;

selecting and starting one of the diagnostic programs (Fig. 4, ref. # 160 and 170,

page 18, lines 2-10) via the first computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)*; and

transmitting results of the one diagnostic program (Fig. 4, ref. # 180, page 18, lines 23-26) to the first computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)*.

Independent apparatus claim 12 recites a computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)* comprising:

a memory *(Fig. 1, ref. # 6, page 8, line 15)*, and at least one of hardware or software configured for selecting and reading out from a database *(Fig. 2, ref. # 16, page 10, line 1)* , in a selection program, an address of a second computing unit *(Figs. 1 and 2, ref. # 2, page 8, line 16)* controlling a printing press *(Fig. 1, ref. # 9, page 8, line 19)*, for establishing a connection with the address of the second computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)*, for initially performing a version comparison between the computing units with respect to an employed communications protocol, and for establishing, after the communications protocol is determined, a data connection for transmitting data, displaying a specified number of diagnostic programs stored (Fig. 4, ref. # 140, page 15, line 25) in said second computing unit *(Figs. 1 and 2, ref. # 2, page 8, line 16)* after the data connection is established, selecting and starting one of the diagnostic programs (Fig. 4, ref. # 160 and 170, page 18, lines 2-10) via the computing unit*(Figs. 1 and 2, ref. # 1, page 8, line 12)*, and transmitting results of the one diagnostic program (Fig. 4, ref. # 180, page 18, lines 23-26) to the computing unit *(Figs. 1 and 2, ref. # 1, page 8, line 12)*.

Grounds of Rejection to be Reviewed on Appeal

1. Whether or not claims 1, 3 - 7, 10 - 12 are obvious over Sridhar (US 6,098,108) in view of Collin, Zeev (WO 00/49501) (hereinafter "Collin") and Waite et al. (US 4,688,170) (hereinafter "Waite") under 35 U.S.C. § 103.

2. Whether or not claims 8 - 9 are obvious over Sridhar in view of Collin and Waite and further in view of Official Notice under 35 U.S.C. § 103.

3. Whether or not claim 13 is obvious over Sridhar, Collin and Waite, and further in view of Kraslavsky et al. (US 5,537,626) (hereinafter "Kraslavsky") under 35 U.S.C. § 103.

Argument:

Whether claims 1 and 12 are obvious over Sridhar in view of Collin and Waite under 35 U.S.C. §103.

Claims 1 and 12 are not obvious over Sridhar in view of Collin and Waite under 35 U.S.C. §103:

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 12 call for, *inter alia*:

displaying a specified number of diagnostic programs stored in said second computing unit after the data connection is established, selecting and starting one of the diagnostic programs via the computing unit, and transmitting results of the one diagnostic program to the first computing unit.

Claims 1 and 12 also call for, *inter alia*:

in the first computing unit, selecting and reading out from a database, in a selection program, an address of the second computing unit controlling a printing unit.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest **all** the claim limitations.

The references do not show or suggest displaying a specified number of diagnostic programs stored in said second computing unit after the data connection is established, selecting and starting one of the diagnostic programs via the computing unit, and transmitting results of the one diagnostic program to the first computing unit, as recited in claims 1 and 12 of the instant application.

The Examiner correctly stated that Sridhar fails to disclose "displaying a specified number of diagnostic programs stored in the second computing unit after the data connection is established; selecting and starting one of the diagnostic programs via the first computing unit; and transmitting results of the one diagnostics program to the first computing unit."

As will be seen from the following comments, the Collin reference **does not** make up for the deficiencies of Sridhar.

The rejection made by the Examiner over Collin is based on a misunderstanding with respect to the words "client" and "server" as used in Collin. The Examiner incorrectly assumes that Collin discloses a typical client-server computer system with one client computer and one server computer. However, Collin discloses a **single** computer system. Therefore, there is only one computer hardware system that runs several programs with program modules, some modules named server applications and some modules named client applications. This is disclosed in Figs. 1 and 2 of Collin and in the corresponding description. Fig. 1 of Collin shows an exemplary computer system and Fig. 2 of Collin shows another embodiment of an exemplary computer system.

Collin discloses that the computer system (100) (Fig. 1) includes a server driver (102) and a server application (104). The single computer system (100) includes an x-system (106) and an x-application (108) (page 7, lines 5-15). However, all the all computer modules (102, 102, 106, and 108) run on the same computer hardware system (100), which is the only computer hardware system. Messages, events, signals and the like can be passed from one of the applications (102, 102, 106, and 108) to another application of the above-mentioned computer modules. There is no second computer hardware unit to which a connection is made via the Internet or via other computer networks.

On page 8, lines 12-26, the instant application discloses that the wording of "computing unit", used in independent claims 1 and 12, is a computer hardware system. This indicates that a first computing unit and a second computing unit are clearly disclosed as two separate computer systems that can communicate via the Internet or other networks. Establishing a connection from a first computing unit to a second computing unit, as disclosed in the instant application, indicates that a network connection is established between the first computer hardware and the second computer hardware. This is contrary to Collin, which discloses passing information from one application to another application **within** the same computer system (100). Collin does not disclose a network connection, Collin only discloses that computer modules on the same computer system (100) interact with each other.

In Fig. 2 and the corresponding specification on page 8, second paragraph, Collin discloses a second exemplary computer system (200), which **does not** interact with the computer system (100). The second computer system (200) is just a second example of an embodiment of a similar computer system. Therefore, the second computer system (200) of Collin is not a second computer system as recited in claims 1 and 12 of the instant application. Instead, it is another computer system like the first computer system (100) of Collin. Collin discloses that the second computer system (200) runs several applications or computer modules like a message server driver (204), a modem system (202), a signal server driver (206), and signal servers (208 and 210). The horizontal line in Fig. 2 of Collin only separates certain levels within one and the same computer system (200), the horizontal line is not a line between two or more computer systems. Collin

discloses that there is a kernel mode level and an application mode level. The kernel mode level is the core program of the computer system, whereas the application mode level is a subsequent level.

In the first paragraph on page 9, Collin discloses that the diagnosis is only done on the second computer system (200), where all messages and reports are created. If desired, support personnel can ask the user to send the data base which has been created on the only computer system (200) to their computer. According to claims 1 and 12 of the instant application, no databases are sent from a first computing unit to a second computing unit. Instead, in the instant application, only one database is stored on a first computing unit wherein all addresses of several second computing units are stored. If a certain second computing unit is selected in the database, a connection is established to the selected second computing unit and then a version comparison between the first and the second computing units is done with respect to an employed communications protocol. After the proper communication protocol has been successfully determined, data connection for transmitting data is established. Next, a number of diagnostic programs stored in the second computing unit are transmitted to the first computing unit so that the user at first computing unit can select and start one of the diagnostic programs in the second computing unit via the first computing unit. Such a process is not disclosed in Collin. In Collin, the diagnostic programs are just stored on the first (only) computer unit and are selected by the user of the first (only) computer unit. When the diagnostics are completed, the whole result wrapped in a database can be sent to the support personnel or the developers' company.

Collin discloses the software architecture of one computer system, which is able to pass the database to a support company. The only disclosure of a second computing system in Collin is on page 9, lines 3-5, where it is disclosed that the interaction is limited to passing a database from a single computer system to support personnel. Collin does not disclose interaction within a client-server system with several computer units. This is contrary to the invention of the instant application, recites displaying a specified number of diagnostic programs stored in said second computing unit after the data connection is established, selecting and starting one of the diagnostic programs via the computing unit, and transmitting results of the one diagnostic program to the computing unit.

Waite does not make up for the deficiencies of Sridhar and Collin.

The references applied by the Examiner **do not** teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, the Sridhar reference discloses an apparatus and method for improving throughput on a data network. Sridhar does not disclose a remote diagnostic service for printing presses. Collin, Waite, and Kraslavsky do not disclose a remote diagnostic service for printing presses.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest **all** the claim limitations.

The references do not show or suggest in the first computing unit, selecting and reading out from a database, in a selection program, an address of the second computing unit controlling a printing unit, as recited in claims 1 and 12 of the instant application.

The Sridhar reference discloses an apparatus and method for improving throughput on a data network. Sridhar does not disclose a remote diagnostic service for printing presses. This is contrary to the invention of the instant application as claimed, which recites in the first computing unit, selecting and reading out from a database, in a selection program, an address of the second computing unit controlling a printing unit.

The Collin and Waite references do not make up for the deficiencies of Sridhar with respect to in the first computing unit, selecting and reading out from a database, in a selection program, an address of the second computing unit controlling a printing unit.

The references applied by the Examiner **do not** teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

The following further remarks pertain to the Collin reference.

The Collin reference does not disclose a connection between two computer systems. Collin discloses only one computer system, more precisely one

processor, having a client module and a server module. Particularly on page 3, second paragraph of Collin, Collin discloses that information is passed from the at least one client module, which sometimes includes passing information from at least one **kernel level** module to the server module. The **kernel** is the most inner part of a computer processor, accordingly there is no second computer system involved. The system shown in figure 2 of Collin is only one computer system. On page 1, first 3 lines of Collin, Collin explicitly discloses that his invention relates to an information system for **compiling** information relating to computer programs. Collin discloses that the system **compiles** information from both **kernel** and passive mode systems. **Compiling** indicates that a computer program in a complex computer language like C++ is translated into a machine computer language like Assembler.

Furthermore, on page 1 of Collin, the **related art** is cited as **kernel debuggers,** software that is used to find bugs in newly written and compiled computer programs. **Debugging** and **compiling** is the work of a computer specialist who writes new software and is not related to data exchange between two computer units over the Internet. Nobody sends uncompiled computer programs from the server to a client over the Internet or another remote computer, because compiling and debugging is done on the computer system the programming person is working on. The related art cited in Collin alone is further evidence that Collin is not related to data exchange between two computer systems but instead, to data exchange within one computer system on the **kernel levels** in the processor, the **kernel levels** being distributed into client and server modules. This is also explicitly shown in figure 2 and disclosed in the specification on pages 8 and 9 of Collin. Another

computer system is shown in figure 1 of Collin that is on the same level as the system in figure 2. A further computer system is shown in figure 3 of Collin, explicitly marked as the kernel mode layer. All three computer systems are part of the invention in Collin and show certain applications on the kernel mode level. In such a computer system, usually as a computer processor, no computer connections have to be established, especially no remote connections. Therefore, Collin is not pertinent to the present invention as claimed.

In the response to arguments on page 3 of the final Office action, the Examiner alleges that "Examiner asserts that Collin discloses this communication between the kernel level merely as one embodiment of employing the method, as the reference clearly states 'sometimes includes', and therefore can not (sic) be enough evidence to support that the functionality of the method is not employed in a two computer connection."

The Examiner's allegation is not reasonable. Particularly, the Examiner's position is based on the fact that everything that is not explicitly excluded in Collin can be read onto two computers, one being a client computer and one being a server computer. Such an interpretation by the Examiner, which has no basis in Collin, while broad, **is not reasonable**. Especially, with respect to the second paragraph on page 3 of Collin, where the Examiner refers to the wording "sometimes includes" which is followed by "passing information from at least one kernel level module to the server module". The limitation introduced by "sometimes includes" however is explicitly restricted and refers to "the information passed from the at least one client module." Throughout the entire disclosure of Collin, "client module" and "server

module" always pertains to parts and applications in the **kernel of one computer**. Therefore, it does not matter what content the information passed from the client module has, since the information is only exchanged between the client module and the server module in a single computer.

Moreover, the Examiner's statement that "the reference clearly states 'sometimes includes', and therefore can not (sic) be enough evidence to support that the functionality of the method is not employed in a two computer connection", is fundamentally flawed. Particularly, it is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest **all** the claim limitations. The Examiner's reliance on the phrase "sometimes includes" not being "enough evidence to support that the functionality of the method is not employed in a two computer connection", does not mean that Collin discloses the method is employed in a two computer connection. However, that is exactly what is required for establishing a *prima facie* case of obviousness. Accordingly, the Examiner's allegation does not meet the requirement for a *prima facie* case of obviousness. Therefore, the honorable Board in requested to disregard the Examiner's comments.

Furthermore, in the response to arguments on page 4 of the Office action the Examiner alleges that "the Examiner asserts that the system as disclosed by Collin clearly indicates to those of ordinary skill in the art that the aforementioned client and server modules implemented via an X-system are **inherently** device independent and network transparent" and that "McGregor was cited only to further evidence of **inherence**"

MPEP § 2112 (8th edition, 1st revision) states that:

> **EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY**
> The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by **probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

As discussed in MPEP § 2112, a limitation recited in a claim that is not expressly or implicitly disclosed in a prior art reference is inherently disclosed therein if, and only if, the "missing" limitation is ***necessarily present*** in the prior art, and that it would be so ***recognized by persons of ordinary skill.*** The principles of inherency require that the inherency be **absolute**, and not probabilistic. As far as appellants were able to ascertain, there is no disclosure or suggestion in *Collin* it is ***absolutely necessary*** that the client and server modules implemented via an X-system are device independent and network transparent and that the data exchange occurs between a first computing unit and a second computing unit. Quite to the contrary, as seen from the above-given remarks with respect to Collin, Collin explicitly discloses that the data exchange occurs on one computer.

Furthermore, according to a sub-heading in MPEP § 2112, the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY", i.e. the Examiner has the burden of proof (by a preponderance of the evidence) to show that *Collin* **necessarily** disclose or suggest purposefully the data exchange . The Examiner's reliance on the McGregor reference is not sufficient to meet the requirement that the "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY".

Moreover, in the response to arguments on page 6 of the final Office action, the Examiner that "[i]n response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking the references individually where the rejections are based on combination of references."

The Examiner is correct, one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. However, Appellant's arguments are merely directed to the Examiner's unreasonable interpretation of what the individual references disclose. Accordingly, Appellants arguments refute features attributed to references as applied by the Examiner to show that the combination of references by the Examiner is deficient for the rejection under 35 U.S.C. §103.

As seen from the above-given remarks, claims 1 and 12 are allowable over Sridhar in view of Collin and further in view of Waite.

Since claim 1 is allowable, dependent claims 3 – 7 and 10 -11 are allowable as well.

Whether claims 8 - 9 are obvious over Sridhar in view of Collin and Waite and further in view of Official Notice under 35 U.S.C. §103.

Claims 8 - 9 are not obvious over Sridhar in view of Collin and Waite and further in view of Official Notice under 35 U.S.C. §103:

Official Notice does not make up for the deficiencies of Sridhar Waite and Collin. Since claim 1 is believed to be allowable, dependent claims 8 and 9 are believed to be allowable as well.

Whether claim 13 is obvious over Sridhar in view of Collin and Waite and further in view of Kraslavsky under 35 U.S.C. §103.

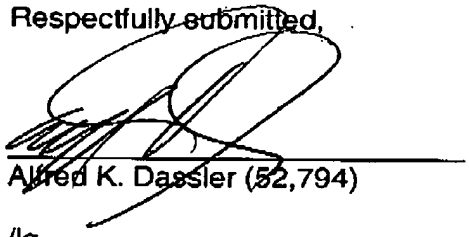
Claim 13 is not obvious over Sridhar in view of Collin and Waite and further in view of Kraslavsky under 35 U.S.C. §103:

Kraslavsky does not make up for the deficiencies of Sridhar Waite and Collin. Since claim 1 is believed to be allowable, dependent claim 13 is believed to be allowable as well.

The honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

Any fees due should be charged to Deposit Account No. 12-1099 of Lerner Greenberg Stemer LLP.

Respectfully submitted,



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Claims Appendix:

1. A method for establishing a data connection and for transmitting data from a first computing unit to a second computing unit, which comprises:

in the first computing unit, selecting and reading out from a database, in a selection program, an address of the second computing unit controlling a printing unit;

establishing a connection with the address of the second computing unit; initially performing a version comparison between the first and the second computing units with respect to an employed communications protocol;

after the communications protocol is determined, establishing a data connection for transmitting data;

displaying a specified number of diagnostic programs stored in the second computing unit after the data connection is established;

selecting and starting one of the diagnostic programs via the first computing unit; and

transmitting results of the one diagnostic program to the first computing unit.

3. The method according to claim 1, which includes:

displaying a specified number of diagnostic programs for monitoring a printing

press connected to the second computing unit;

selecting and starting one of the diagnostic programs via the first computing unit; and

transmitting results of the one diagnostic program to the first computing unit.

4. The method according to claim 3, which includes providing a table wherein diagnostic programs are assigned to specified printing presses, so that when establishing a connection, the diagnostic programs pertaining to a printing press are displayed for selection.

5. The method according to claim 3, which includes, depending upon the diagnostic program that is selected, establishing a communications protocol via which data are transmitted between the first and the second computing units.

6. The method according to claim 3, which includes, depending upon the diagnostic program that is selected, providing a specified number of data ports via which data are transmitted.

7. The method according to claim 6, which includes transmitting specified data only via specified data ports.

8. The method according to claim 7, which includes outputting the data in parallel via the data ports, and transmitting the data output serially in data packets via the

data connection.

9. The method according to claim 8, which includes providing in each data packet an identifier for the data port, which indicates the data port from which the data were output.

10. The method according to claim 1, which includes selecting a type of control with which the printing press is controlled by the computing unit and, depending upon the control that is selected, selecting at least one of a communications protocol and a diagnostic program.

11. The method according to claim 1, which includes selecting a type of control with which the printing press is controlled by the computing unit and, depending upon the control that is selected, displaying at least one of a communications protocol and a diagnostic program for selection.

12. A computing unit comprising:

a memory, and at least one of hardware or software configured for selecting and reading out from a database, in a selection program, an address of a second computing unit controlling a printing press, for establishing a connection with the address of the second computing unit, for initially performing a version comparison between the computing units with respect to an employed communications protocol, and for establishing, after the communications protocol is determined, a data connection for transmitting data, displaying a specified number of diagnostic

programs stored in said second computing unit after the data connection is established, selecting and starting one of the diagnostic programs via the computing unit, and transmitting results of the one diagnostic program to the computing unit.

13. The method according to claim 1, wherein the diagnostic programs stored in the memory of the second computing unit are used for monitoring a printing press.

Evidence Appendix:

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence has been entered by the Examiner and relied upon by appellant in the appeal.

Related Proceedings Appendix:

No prior or pending appeals, interferences or judicial proceedings are in existence which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal. Accordingly, no copies of decisions rendered by a court or the Board are available.